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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,099	02/11/2004	Yasushi Sano	Q79674	1568

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EXAMINER

CHEA, THORL

ART UNIT PAPER NUMBER

1752

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/775,099

Applicant(s)

SANO ET AL.

Examiner

Thorl Chea

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 10/186,392.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>02112004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims are unclear. First, it unclear whether the claims are direct to two different processes or otherwise. See the language “A method for liquid preparation of photographic reagent comprising at least a process of measuring the photographic reagent and a process of heat-meting the photographic reagent”. It is also unclear with respect processing steps in each process of measuring the photographic reagent and the process of heat-meting the photographic reagent since the claims fail to clearly cited such steps of the processes. The scope of protection sought for the “photographic reagent” is unclear since the specification fails to clearly define the scope thereof. The specification discloses only the use of claimed method in the preparation of liquid of a silver halide emulsion. However, the term “photographic reagent” encompasses the scope of any reagent useful in a formation of a photographic material, which extends beyond the scope of silver halide. Therefore, it is unclear whether it was intended to claim the photographic reagent other than the silver halide emulsion or otherwise. The claiming of “repeating the steps for every liquid preparation” is unclear whether this repeating step is a part of the claimed method or repeating step of preparing another liquid using the transferring and heating steps. The

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term "measuring" is unclear with respect to which quantity to be measured, i.e., weight, volume, temperature, mass or other.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 1 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bagchi et al (US Patent No. 5,385,812).

Bagchi et al discloses a method for preparing a microprecipitated photographic reagent using similar process as claimed. See Fig. 3, sheet 3 of 10 and the description thereof in column 5, lines 50-68 and column 6, lines 1-48 wherein the photographic reagent was transferred through a pipe (63,67) without being heated to the tank 70 with water jacket 71; the pumping rate of pump 60 is adjusted to a desired value prior to the run to produce the melt with predetermined photographic reagent concentration; the pump 64 is adjusted to the desired value prior to the run to produce a melt of the desired gelatin concentration. See also the flow meter (62, 68). This method is used for every

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photographic reagent such as dye, surfactant, stabilizer and absorbing compound in columns 8-9, and column 17, claim 2. The amount of the melt in tank 70 is therefore measured through the flow meter, and therefore the amount has been measured and known. Bagchi et al may not clearly state that the "measuring tank" presented in the claimed invention, but the tank taught in Bagchi et al and presented claimed invention serve similar function. Accordingly, the invention as claimed is either anticipated or found obvious to the worker of ordinary skill in the art.

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bagchi et al as applied to claim 1 above, and further in view of Bosvot et al (US Patent No. 5,264,024). Bosvot discloses the process of melting silver halide emulsion. It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to use the process taught in Bagchi et al to melt the silver halide emulsion taught in Bosvot et al with a reasonable expectation of achieving a useful coating composition, and thereby provide a process as claimed.

7. Claim 2 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (571) 272-1328.

The examiner can normally be reached on 9 AM-5:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H Kelly can be reached on (571)272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tch
January 5, 2005

Thorl Chea
Primary Examiner
Art Unit 1752

A handwritten signature in black ink, appearing to read "Thorl Chea", is written below the printed name and title.